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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/581,398	03/22/2007	Jonathan Rogers	EL/2-22992/A/PCT	9479
324	7590	07/31/2009		
JoAnn Villamizar Ciba Corporation/Patent Department 540 White Plains Road P.O. Box 2005 Tarrytown, NY 10591			EXAMINER CHUNG, SUSANNAH LEE	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 07/31/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/581,398	Applicant(s) ROGERS ET AL.	
	Examiner SUSANNAH CHUNG	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 14-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-13-06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-18 are pending in the instant application.

Priority

This application is a 371 of PCT/EP04/53111, filed 11/26/2004.

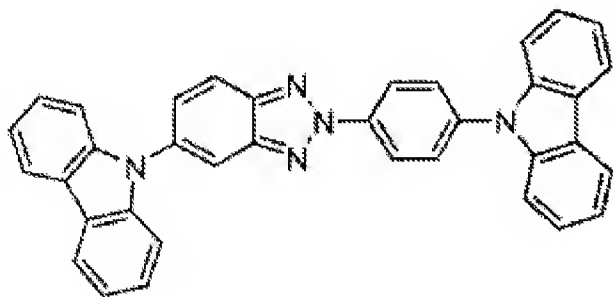
Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) by application nos. 03104562.8 and 04104279.7 filed in the European Patent Office on 12/05/2003 and 09/06/2004, which papers have been placed of record in the file. The application names an inventor or inventors named in the prior application.

Information Disclosure Statement

The information disclosure statement (IDS), filed on 10-13-2006 has been considered. Please refer to Applicant's copy of the 1449 submitted herewith.

Response to Election/Restrictions

Applicant's election *without traverse* of Group II, claims 10-13, in the reply filed on 5-4-2009 is acknowledged. The election of



for search and examination purposes is acknowledged.

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Scope of the Elected Invention

Claims 1-18 are pending in this application. Claims 1-9, 14-18 are withdrawn from further consideration by the examiner, 37 C.F.R. §1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

The scope of the elected subject matter that will be examined and searched is as follows: Claims 10-13 in its entirety.

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims must stand alone to define the invention and incorporation into claims by express reference to the specification is not permitted. Ex parte Fressola, 27 USPQ 2d 1608. Claims 10-13 are dependent on claim 1 and refer back to limitations in claim 1. Without the limitations of claim 1, claims 10-13 are indefinite. It is suggested that Claim 10 be drafted in independent claim form and the limitations of claim 1 be inserted into claim 10.

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Obviousness Double Patenting

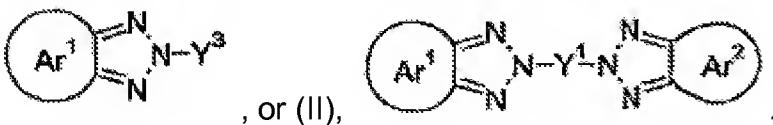
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

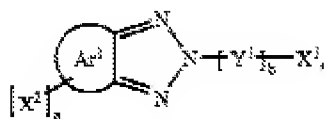
Claims 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-6 of US Pat. No. 7,541,096 ('096 Pat).

Instant claim 10 claims an electroluminescent device of formula (I),



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'096 Claims 1-6, claim an electroluminescent device of formula



, wherein Y1 is a divalent linking group or absent, X1 is



The difference between the prior patent and the instant claims is the scope of the benzotriazole compounds being claimed. The scope of the instant claims is broader than the '096 Pat.

Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would recognize that the compounds claimed in the '096 Pat overlap or are the same as the claims. A difference in the scope of the claims is obvious and does not change the method of making of the claimed compounds or the method of using the compounds, i.e. the utility of the compounds as electroluminescent devices.

In the absence of showing unobvious results, it would have been obvious to one of ordinary skill in the art at the time of the invention when faced with the prior filed applications that the instantly claimed compounds would be known. The motivation to optimize this class of benzotriazole compounds is the expectation that they will have similar electroluminescent properties.

The instant obviousness rejection is based on the close structural similarity of the instantly claimed compounds to the prior filed application compounds and the common

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utility shared among the compounds. There is an expectation among those of ordinary skill in the art that similar structural compounds will have similar properties and that modification of a known structure is mere experimentation within the means of a skilled artisan. See MPEP 2144.09(I). Therefore, claims 10-13 are rejected as obvious over the prior claims.

Claim Rejections - 35 USC § 102

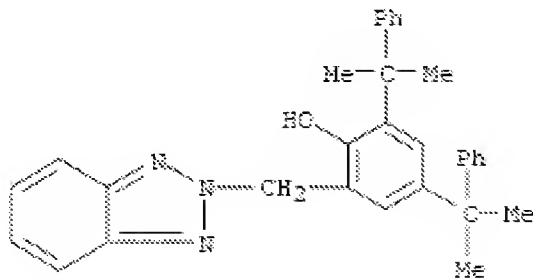
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Roitman et al (U.S. Pat. No. 5,629,389).

Applicants claims relate to an electroluminescent device using a benzotriazole compounds of Formula (I) and (II) in claims 10-13. Roitman discloses an electroluminescent device using 2-(2H-benzotriazol-2-ylmethyl)-4,6-bis(1-methyl-1-



phenylethyl)-phenol,

, which reads on the

instant claims. See Roitman, et al., US Pat No. 5,629,389, columns 2-4, claims 1-5.

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Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Susannah Chung/
Examiner, Art Unit 1626